



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York NY 10008-0770

MAILED

MAR 12 2010

OFFICE OF PETITIONS

In re Application of :
Yoshio Ishii et al. :
Application No. 10/813,558 :
Filed: March 29, 2004 :
Attorney Docket No. 04110/0201116-US0 :

DECISION ON PETITIONS

This is a decision on the request under 37 CFR 1.48(a), filed February 12, 2010, with a petition under 37 CFR 1.183 requesting a waiver of 37 CFR 1.48(a) to permit the deletion of originally named inventor Kozo Shirato (Shirato) without his statement that the error in inventorship occurred without deceptive intention on his part.

The request and petition are **dismissed**.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

The request under 37 CFR 1.48(a) lacks compliance with items (1) and (2).

In regard to item (2), the request lacks the statement from Shirato that the error in inventorship occurred without deceptive intention on his part. The petition under 37 CFR 1.183 requests waiver of this requirement since Shirato was presented with an opportunity to make such a statement but refused to make the statement.

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a petition and fee under 37 C.F.R. 1.183 (along with the request and fee under 37 C.F.R. 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). Here, the facts of record do not unequivocally support the correction sought since Shirato allegedly refuses to cooperate despite being given the opportunity. The reason for the refusal was not given in the declaration by Yoshio Ishii (Ishii). Moreover, while Ishii declared on the record that the refusal was made, he received information regarding the refusal from a third party, Toshizo Nozaki, and does not have first hand knowledge of the refusal. The refusal and reason for refusal should be stated in an affidavit or declaration by the party to whom the refusal was made, and in the event that the refusal is in writing, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration. Also, an unexplained refusal alleged through reliance on third party information does not constitute an extraordinary situation in which justice requires waiver of a rule pursuant to 37 CFR 1.183. Accordingly, the USPTO will not relax the requirements of 37 CFR 1.48 by way of 37 CFR 1.183.

Petitioners may wish to consider MPEP 201.03 II.A., which states:

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications.

In regard to item (1), the request does not clearly sets forth the desired inventorship change. The request and substitute declaration indicate that the inventorship should be changed to Yoshio Ishii, Koji Tanemura and Toshihiko Matsumoto. However, the supplemental Application Data Sheet (ADS) indicates that the inventors are Yoshio Ishii, Koji Tanemura, Toshihiko Matsumoto and Kozo Shirato. Although the totality of the request and petition suggest that the inventors after the desired change should be Yoshio Ishii, Koji Tanemura and Toshihiko Matsumoto, clarification of the record is required.

Deposit Account 04-0100 has been charged the fees under 37 C.F.R. §§ 1.17(i) and 1.17(f) for consideration of the petitions under 37 C.F.R. §§ 1.48 and 1.183, as authorized in the request under 37 CFR 1.48(a) and the PART B – FEE(S) TRANSMITTAL filed February 8, 2010.

Any inquiries concerning this communication may be directed to the undersigned at (571) 272-6692.

A handwritten signature in black ink, appearing to read "Chris Bottorff", written in a cursive style.

Christopher Bottorff
Petitions Examiner
Office of Petitions